

REMARKS/ARGUMENTS

Prior to entry of this Amendment, claims 11-17, 19-23, 32-49, 51-53, and 58-64 were pending in this application. An office action mailed January 10, 2007 rejected all pending claims on a variety of grounds, as discussed in further detail below. This amendment amends claims 32, 48, 49, 51-53 and 63. Claim 59 has been canceled, and claim 65 has been added. Therefore, after entry of this amendment, claims 11-17, 19-23, 32-49, 51-53, and 58-64 remain pending for examination. Claims 45, 63 and 64 are independent claims. The applicant respectfully requests reconsideration of the rejected claims for at least the reasons presented below.

Claim Amendments

Claims 32, 48, 49 51-53 and 63 have been amended. Claim 32 has been amended to more clearly recite that the computer system to which claim 32 is directed comprises a database. Claims 48 and 49 have been amended for consistency with claim 45, from which they depend, to recite "providing an interface for a user to review." Claims 51-53 have been amended to depend from claim 45. Claim 63 has been amended to more clearly point out that the processor and the computer readable memory are distinct elements.

Claim 65 has been added. Support for the elements of claim 65 can be found throughout the application, including in particular in existing claim 45 (and the portions of the specification supporting that claim), as well as at page 13, line 16 through page 15 line 25 of the application.

Claim 59 has been canceled without prejudice or disclaimer in the interest of reducing excess claim fees.

35 U.S.C. § 112 Rejections

The office action rejected various groups of claims under 35 U.S.C. § 112. Specifically, the office action rejected claims 32-44 and 63 under § 112, ¶ 1 as being of undue

breadth. The office action further rejected claims 63 and 32-44 under § 112, ¶ 2 as being indefinite. In addition, the office action rejected claims 34 and 35 under § 112, ¶ 2 as being indefinite. The office action also rejected claims 11-17, 19-23, 46-49, and 58-62 under § 112, ¶ 2, as being indefinite, rejected claims 48 and 49 under § 112, ¶ 2 as being indefinite, rejected claims 51-53 under § 112, ¶ 2 as being indefinite and rejected claim 59 under § 112, ¶ 2 as being indefinite. These rejections are traversed in part and, it is submitted, have been overcome in part, as described in further detail below.

1. Rejection of claims 32-44 and 63 under § 112, ¶ 1

The office action rejected claims 32-44 and 63 under § 112, ¶ 1 as being of undue breadth. Specifically, the office action contended that claim 63 is a “single means” claim, and apparently found that claims 32-44, which depend from claim 63, suffer from the same alleged deficiency. These rejections are traversed, and it is respectfully submitted that the office action’s findings are unsupported, for at least two reasons.

First, the case on which the rejection relies, *In re Hyatt*, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983) defines a “single means claim” to be “a claim drafted in ‘means-plus-function’ format yet reciting only a single element instead of a combination.” 708 F.2d at 713. The MPEP provides a substantially similar definition: “A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means” MPEP § 2164.08(a). In contrast, claim 63 does not recite any “means-plus-function” elements. Instead, it recites a processor and a computer readable memory, in addition to several instructions encoded on the computer readable memory. Accordingly, there is no basis for describing claim 63 as a single means claim.

Second, even assuming one of the elements recited by claim 63 might be considered a “means-plus-function” element (and none of the elements reasonably can be construed this way), claim 63 recites seven different elements in combination (the processor, the computer readable memory, and five instruction elements). For at least this additional reason, claim 63 properly cannot be rejected as a single means claim. Claims 32-44, which depend from claim 63, necessarily include all of the elements of claim 63 and the rejection of those claims,

therefore, is improper as well. Reconsideration of the rejections of claims 63 and 32-44 is respectfully requested.

2. Rejection of claims 32-44 and 63 under § 112, ¶ 2

The office action also rejected claims 32-44 and 63 under § 112, ¶ 2 as being indefinite. Specifically, the office action contends that claim 63 recites only a processor, and “it takes more than a processor to execute the instructions of the computer-readable medium.” Office Action, at 3. Moreover, the office action contends that “claims 32-44 are directed to instructions, not structure.” These rejections are respectfully traversed, and reconsideration is requested. As an initial matter, claim 63 recites both a processor and a computer-readable memory (which stores instructions that are executable by the processor), and has been cosmetically amended to reflect that fact. In addition, one skilled in the art would appreciate that the processor of a computer system does indeed execute instructions, such as those recited by claim 63. To address the rejection under § 112, ¶ 2, however, claim 63 has been amended to more clearly indicate that “the computer-readable memory compris[es] a set of instructions executable by processor to cause the computer system to perform a set of operations.” It is believed that this amendment will address any possible concern about “it tak[ing] more than a processor to execute the instructions of the computer readable medium,” and reconsideration of the rejection of claim 63 under § 112, ¶ 2 is respectfully requested. If the Office believes that the amended claim still fails to provide notice to one skilled in the art of what is being claimed, the applicant respectfully requests a more detailed ground of rejection in the next office action.

Regarding the rejections of claims 32-44, it is believed that those claims are more than clear enough for one skilled in the art to ascertain what is being claimed. Paragraph 2 of § 112 requires only that “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” While claim 63 is directed to a computer system, it specifically recites “a set of instructions,” and claims 32-44 each further define the nature of the set of instructions. The office action cites no authority for the implied proposition that a dependent claim cannot further limit a particular element of a base claim without running afoul of § 112, ¶ 2. If the Office is

aware of some authority supporting that position, the applicant respectfully requests a citation of such authority. Otherwise, reconsideration of the rejections is respectfully requested.

3. Rejection of claims 34 and 35 under § 112, ¶ 2

The office action rejected claims 34 and 35 under § 112, ¶ 2 as being indefinite. Specifically, the office action objects to the recitations in claims 34 and 35 that further define the database recited in claim 32, noting that neither claim 32 nor claim 63 (from which it depends) actually recites a database as an element of the computer system to which those claims are directed. Once again, it is believed that there is no legal support for these rejections. In the interest of expediting prosecution, however, claim 32 has been amended to recite that “the computer system further compris[es] a database.” It is believed that this amendment addresses the objections to claims 34 and 35, and reconsideration of those claims is respectfully requested.

4. Rejection of claims 11-17, 19-23, 46-49, and 58-62 under § 112, ¶ 2

The office action rejected claims 11-17, 19-23, 46-49, and 58-62 under § 112, ¶ 2 as being indefinite because “Claim 45 has a limitation of providing for the transmission of the electronic information [disclosure] statement. This is not a positive recitation.” Office Action, at 4. The applicant respectfully disagrees. The element at issue cannot be construed as a negative limitation, and in any case, negative limitations are permissible under § 112. *See* MPEP § 2173.05(j). Rather, claim 45 positively recites “providing for the transmission of the electronic information disclosure statement to the official patent office.” One skilled in the art would easily understand this element to mean taking one or more actions to initiate, facilitate and/or accomplish transmitting the electronic information disclosure statement to the official patent office, without necessarily requiring the actual transmission itself. Examples of actions that can be taken to provide for transmission of the electronic information disclosure statement are recited by claims 46 and 47. Accordingly, it is respectfully submitted that claim 45 complies with § 112, ¶ 2. Claims 11-17, 19-23, 46-49, and 58-62 (which depend from claim 45) were rejected on the same ground, and they are believed to be allowable under § 112, ¶ 2 as well. Reconsideration of the rejections is respectfully requested.

5. Rejection of claims 48 and 49 under § 112, ¶ 2

The office action rejected claims 48 and 49 under § 112, ¶ 2 as being indefinite because “Claim 48 is directed to a limitation of allowing a user to review one or more electronic documents.” Claims 48 and 49 have been amended, as noted above, to recite “providing an interface for a user to review,” and it is believed that these amendments address the ground of rejection of claims 48 and 49. Reconsideration of the amended claims is respectfully requested.

6. Rejection of claims 51-53 under § 112, ¶ 2

The office action rejected claims 51-53 under § 112, ¶ 2 as being indefinite for depending from a cancelled claim. Claims 51-53 have been amended to depend from claim 45, which is currently pending. It is believed that these amendments address the grounds of rejection.

7. Rejection of claim 59 under § 112, ¶ 2

The office action rejected claim 59 under § 112, ¶ 2 as being indefinite. Claim 59 has been canceled, as noted above, and it is believed that the rejection of claim 59 is moot.

35 U.S.C. § 101 Rejection

Claim 64 has been rejected under 35 U.S.C. § 101 because the claimed invention allegedly is directed to non-statutory subject matter. This rejection is traversed. The office action states, as ground for the rejection, that “Claim 64, as written, is claiming only instructions.” The applicant respectfully disagrees. Rather, claim 64 recites, “[a] computer software program embodied on a computer-readable memory, the computer software program comprising a set of instructions executable by a computer.” According to the MPEP, “a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.” MPEP § 2106.01. Claim 64 recites a computer program embodied on a computer-

readable memory, and is therefore directed toward statutory subject matter. Reconsideration of claim 64 is respectfully requested.

35 U.S.C. § 103 Rejections

Claims 11-17, 19, 21-23, 32-49, 51-53 and 58-64 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over US 2003/0046307 to Rivette et al. (hereinafter, "Rivette") in view of U. S. Patent No. 6,049,811 to Petruzzi et al. (hereinafter, "Petruzzi") in view of US 2001/0049707 to Bao Q. Tran (hereinafter, "Tran"). Claim 20 was rejected under § 103(a) as being unpatentable over Rivette, Petruzzi and Tran, further in view of U.S. Patent No. 6,434,580 to Takano et al. (hereinafter, "Takano"). These rejections are respectfully traversed.

The office action relies primarily on Rivette in rejecting the pending claims. All of the present claims generally are directed to tools for producing electronic information disclosure statements. Rivette, in contrast, generally discloses a system for maintaining databases of patents (and non-patent information) and for processing groups of patents (Rivette, abs.) It is believed, however, that Rivette does not even mention any tools for prosecuting pending applications (as opposed to categorizing and valuing issued patents). Accordingly, Rivette has no need to deal with information disclosure statements, which, one skilled in the art would appreciate, generally are pertinent only to pending applications, not issued patents. (Indeed, a text search of the Rivette reference fails to identify a single mention of an "information disclosure statement," of disclosing references to a patent office, or of any other tasks generally associated with citation of references, other than describing tools for searching and cataloging citations on the faces of issued patents, *see generally* Rivette, Figs. 86 and 87).

Hence it is perhaps unsurprising that Rivette fails to disclose many elements of even the independent claims in the application.

1. **Claim 45**

- a) **The cited references fail to disclose a computer interface that is configured to allow the user to identify an electronic document as being relevant to a patent application.**

Consider, for example, claim 45, which recites, inter alia, “providing a computer interface for a user to review one or more electronic documents, wherein the computer interface is configured to provide a prompt to allow the user to identify at least one electronic document as being relevant to a patent application.” None of the cited references teach or suggest this element.

The office action contends that paragraphs 0393, 0396 and 0407 of Rivette teach this element. Those paragraphs disclose tools for searching for documents, and optionally for selecting a document to be reviewed. Nothing in the cited paragraphs, however, teaches or suggests “a prompt to allow the user to identify at least one electronic document as being relevant to patent application,” as recited by claim 45. Moreover, as noted in the amendment filed October 30, 2006, neither Tran nor Petruzzi teach this element. While Takano does teach some sort of automated prior art keyword search in order to “revise the draft [application] data so as to make the contents of the draft data (the contents of the invention) novel and unobvious,” Takano, col 14, ll. 31-64, a review of Takano reveals no disclosure of any sort of prompt to allow the user to identify an electronic document as being relevant to a patent application. Hence, the cited references collectively fail to teach or suggest this element, and claim 45 is allowable over the cited references for at least this reason.

- b) **The cited references fail to disclose any extraction of information from an electronic document for use in an information disclosure statement.**

Nor do any of the cited references teach or suggest the combination of “receiving, from the user and via the interface, a signal indicating that the at least one electronic document should be disclosed to the patent office,” and “in response to the signal, extracting, via an automated process and from the at least one electronic document, a set of information to be used in an information disclosure statement,” as recited by claim 45. Once again, the office action

relies on Rivette (¶¶ 1157 and 1193) as teaching these elements. The cited paragraphs, however, provide no such teaching. Paragraph 1157 discloses, in its entirety,

The operator can restructure the group hierarchy displayed in the Group pane 11704 using well-known drag-and-drop operations. The operator can add any of the documents displayed in the Document pane 11706 to any group in the group hierarchy displayed in the Group pane 11704 by using well-known drag-and-drop operations,

Rivette, ¶ 1157. Paragraph 1193 discloses, in its entirety,

The operator presses an Add a Patent/Document button 13608 in the Document toolbar 11726 in order to add a patent or some other document to the group selected in the Group window 11704. Upon pressing the Add a Patent/Document button 13608, a new Document window 13006 is displayed (FIG. 130). The operator inserts information identifying the document that is to be added to the selected group in a Document Name field 13008. In an alternative embodiment, the operator can select a document for insertion into the selected group by browsing through a graphical list of the documents in the Document databases 612, and use well-known drag and drop techniques to place documents into the selected group.

Id., ¶ 1193.

Neither of the cited passages (nor, it is believed, any other portion of Rivette) teaches or suggests the elements quoted above. Instead, both of these passages merely disclose procedures for adding documents to a group. Rivette defines a “group” as “a data structure that includes a collection of patents. The patents in a group typically follow a common theme or characteristic (although this is not a mandatory requirement of groups).” *Id.*, ¶ 0264. Nowhere does Rivette even suggest that adding an electronic document to a group might comprise either “receiving, from the user and via the interface, a signal indicating that the at least one electronic document should be disclosed to the patent office,” or “in response to the signal, extracting, via an automated process and from the at least one electronic document, a set of information to be used in an information disclosure statement,” as recited by claim 45.

In particular, there is no indication in Rivette that placing a document into a selected group somehow acts to extract a set of information from the document, let alone extracting such information to be used in an information disclosure statement. (As noted above, it is believed that Rivette fails even to mention the concept of an information disclosure statement, or anything that could be considered analogous thereto.)

Moreover, as discussed in the October 30, 2006 amendment, neither Petruzzi nor Tran provides any relevant disclosure in this regard. Takano likewise fails to disclose these elements. Hence, for at least this additional reason, claim 45 is believed to be allowable over the cited references.

c) The cited references fail to disclose incorporating information into an electronic disclosure statement.

Nor do any of the cited references teach or suggest, as recited by claim 45, incorporating, with an automated process, at least some of the extracted information from the electronic document into an electronic information disclosure statement, . . . wherein the at least one electronic document includes information corresponding to a plurality of fields in the electronic information disclosure statement, and wherein incorporating at least some of the extracted information comprises storing the at least some of the extracted information in the corresponding plurality of fields in the electronic information disclosure statement.

The office action correctly concedes that Rivette fails to teach or suggest even the concept of an electronic information disclosure statement. The office action, however, contends that Petruzzi (col. 2, ll. 65-67 and col. 5, l. 48 – c. 6, l. 7) teaches these elements. This first passage cited by the office action has nothing to do with electronic information disclosure statements, rather, it provides, as an object of Petruzzi's invention, "a method of analyzing and presenting an invention in the form appropriate for filing with the Patent and Trademark Office." Petruzzi, c. 2, ll. 65-67 (emphasis added). In other words, this passage pertains to the preparation of a patent application, not an information disclosure statement.

As the office action correctly notes, Petruzzi does touch on the concept of information disclosure statements. Petruzzi, however, teaches that "the operator is prompted for references, a brief description of each reference, and the relevance of each reference with respect to the invention." Petruzzi, c. 5, l. 67 – c. 6, l. 7. Hence, Petruzzi neither teaches nor suggests that any information extracted from an electronic document might be incorporated with an automated process into an electronic information disclosure statement, but instead teaches the manual insertion of data into the form.

Moreover, the office action fails to identify, and a review of Petruzzi fails to reveal, any disclosure that "the at least one electronic document includes information

corresponding to a plurality of fields in the electronic information disclosure statement, and wherein incorporating at least some of the extracted information comprises storing the at least some of the extracted information in the corresponding plurality of fields in the electronic information disclosure statement,” as recited by claim 45.

For their part, Tran and Takano each fail to disclose such elements. Accordingly, for at least this additional reason, claim 45 is believed to be allowable over any combination of Rivette, Petruzzi, Tran and Takano.

2. Claims 63 and 64

Claims 63 and 64 are directed to a computer system and a computer software program, respectively, and they each recite elements similar to those recited by claim 45. Accordingly, claims 63 and 64 are believed to be allowable over any combination of Rivette, Petruzzi, Tran and Takano for at least reasons similar to those discussed above.

3. Dependent Claims

Claims 11-17, 19-23, 32-44, 46-49, 51-53, and 58-62 each ultimately depend from either claim 45, claim 63 or claim 64. These dependent claims are believed to be allowable at least by virtue of their dependence from allowable base claims.

4. New Claim 65

Claim 65 is an independent claim, and it recites certain elements similar to those described above. Merely by way of example, claim 65 recites, inter alia, “in response to the selection of the portion of the web page, extracting, from the selected portion of the web page, a set of information to be used in the information disclosure statement, and “incorporating, with an automated process, at least some of the extracted information from the electronic document into the electronic information disclosure statement,” wherein “incorporating at least some of the extracted information comprises identifying a field corresponding to the selected portion of the web page, based on the selection of the type of information to be incorporated, and storing the at least some of the extracted information in the identified field in the electronic information

disclosure statement.” As noted above, none of the cited references teach or suggest either extracting information from an electronic document or incorporating any extracted information into an electronic information disclosure statement.


In addition, claim 65 recites several additional novel elements that are believed to be missing from the respective disclosures of Rivette, Petruzzi, Tran and Takano. Accordingly, claim 65 is believed to allowable over any combination of those references.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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